

ESTTA Tracking number: **ESTTA753834**

Filing date: **06/22/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	Conseil Interprofessionnel du Vin de Bordeaux
Granted to Date of previous extension	06/22/2016
Address	1, Cours du XXX Juillet Bordeaux, 33075 FRANCE

Name	Institute National de l'Origine et de la Qualite
Granted to Date of previous extension	06/22/2016
Address	12 rue Henri Rol-Tanguy TSA 30003 Montreuil-Sous-Bois Cedex, 93555 FRANCE

Attorney information	Peter M. Brody Ropes & Gray LLP 2099 Pennsylvania Avenue, NW Washington, DC 20006-6807 UNITED STATES trademarks@ropesgray.com Phone:202-508-4612
----------------------	-----------------------------------------------------------------------------------------------------------------------------------------------------------------

Applicant Information

Application No	86610511	Publication date	02/23/2016
Opposition Filing Date	06/22/2016	Opposition Period Ends	06/22/2016
Applicant	Small World Wine Company 3700 NW Marshall Drive Corvallis, OR 973309780 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. First Use: 2007/02/23 First Use In Commerce: 2015/01/10

All goods and services in the class are opposed, namely: Acanthopanax wine (Ogapiju); Aperitif wines; Aperitifs with a wine base; Black raspberry wine (Bokbunjaju); Cooking wine; Dessert wines; Fortified wines; Fruitwine; Grape wine; Honey wine; Kits for making wine; Korean traditional rice wine (makgeoli); Natural sparkling wines; Port wines; Prepared wine cocktails; Red wine; Red wines; Rose wine; Rose wines; Sparkling fruit wine; Sparkling grape wine; Sparkling wines; Still wines; Strawberry wine; Sweet wines; Table wines; Tonic sweet grape wine containing extracts from ginseng and conchona bark (ninjin-kinatetsu wine); White wine; White wines; Wine; Wine coolers; Wine punch; Wine punches; Wine-based beverage, namely, piquette; Wine-based drinks; Wines and fortified

wines; Wines and liqueurs; Wines and sparkling wines

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
The mark is primarily geographically deceptively misdescriptive	Trademark Act Section 2(e)(3)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)
Geographic indication which, if used on or in connection with wine or spirits, identifies a place other than the origin of the goods	Trademark Act Section 2(a)

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	The AOC designation of BORDEAUX for certain wines produced in the Bordeaux region of France, in accordance with methods and limitations set forth in French law.		
Goods/Services	Certain wines produced in the Bordeaux region of France, in accordance with methods and limitations set forth in French law.		

Attachments	06222016_121964_NOO_Pleading.pdf(315571 bytes)
-------------	-------------------------------------------------

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/p brody/
Name	Peter M. Brody
Date	06/22/2016

INSTITUT NATIONAL DE L'ORIGINE ET DE LA QUALITÉ,)	
)	
and)	Opposition No. _____
)	
CONSEIL INTERPROFESSIONAL DU VIN DE BORDEAUX,)	Application Serial No. 86/610,511
)	
Opposers,)	Mark: OR'DEAUX
)	
v.)	Published in the Official Gazette of February 23, 2016
)	
SMALL WORLD WINE COMPANY,)	
)	
Applicant.)	
)	

Opposers, the Institut National de l’Origine et de la Qualité (hereinafter “INAO”), an entity organized and existing under the laws of the Republic of France and headquartered at 12, rue Henri Rol-Tanguy, TSA 30003, 93555 Montreuil-Sous-Bois, France, and the Conseil Interprofessionnel du Vin de Bordeaux (hereinafter “CIVB”), an entity organized and existing under the laws of the Republic of France, and located at 1, cours du XXX Juillet, Bordeaux, 33075, France, hereby oppose the application (“Application”) filed on April 27, 2015, by applicant Small World Wine Company (“Applicant”) to register the mark “OR’DEAUX” in International Class 33 for use of said mark on or in connection with “Acanthopanax wine

products from which the product may be derived and the agricultural and production methods and techniques that may be used to make the product. “Bordeaux” is one such AOC.

2. Compliance with the appellation of origin and AOC system is monitored by the INAO, in conjunction with other governmental agencies and certain nongovernmental organizations, which are responsible for the protection of specific AOCs. The INAO receives funds listed in the budget of the Ministry of Agriculture, the amount of which generally reflects a portion of the proceeds of a special tax paid by producers of French appellation of origin products, and which is based on the volume of such products produced and sold under this system.

3. Opposer CIVB was established by decree of the French Republic on January 5, 1941. Its members are wine and spirits growers, producers and merchants representing growers, producers and merchants from the Bordeaux region of France. The function of the CIVB is, *inter alia*, to act on behalf of the Bordeaux wine and spirits growers, producers and merchants, to increase demand for Bordeaux region products by promoting the sales of such products in national and international markets, to promote and protect the Bordeaux appellations of origin, and otherwise represent the economic and legal interests of growers, producers and merchants of Bordeaux wines and spirits. Funding supporting the CIVB derives from both a special tax based on the volume of wines and spirits sold and produced, and from dues paid by growers, producers and merchants of the Bordeaux region.

4. “Bordeaux” is among the particular “AOCs” recognized and protected by French law for many decades. This appellation is well known, and is the distinctive designation of a popular and high quality product. By decrees of 1909 and 1936, the French government has

restricted the use of the name “Bordeaux” to wines and spirits that meet prescribed standards of quality and content, and that are produced in the Bordeaux region at locations, and under conditions, specified and regulated by French law, as supervised and enforced by the INAO and the CIVB. These legal requirements are comprehensive and concern, *inter alia*, the varietal type of grapes that may be used, the permitted techniques of distillation, and the prescribed duration of and methods for aging. Use of the designation “Bordeaux” constitutes an assurance by the INAO and CIVB, which are charged by French law with the responsibility and authority for safeguarding the integrity of this important French designation, that the product bearing that designation has been produced in accordance with these strict standards.

5. The use of the AOC “Bordeaux” is in fact controlled by a certifier and limited to products meeting the certifier's standards of regional origin.

6. The AOC “Bordeaux” denotes, and is understood by United States consumers to denote, a specific regional origin. Products qualifying for this AOC have been validly and continuously sold in the United States for a period beginning long prior to the filing date of Applicant's application, and continuing to the present. The AOC “Bordeaux” is symbolic of the good will and consumer recognition built up through the efforts and investments of the CIVB and INAO in the appellation of origin system and this specific AOC, and through the promotion and sales of these quality products by those certified by the CIVB and INAO to use this AOC.

7. The AOC “Bordeaux” is recognized under United States wine labeling regulations as a foreign nongeneric name of geographic significance which is also a distinctive designation of a specific grape wine. *See* 27 C.F.R. §§ 4.24(c), 12.31(b). Those regulations restrict the use

of “Bordeaux” – including use as a brand name – to wines entitled to bear the AOC “Bordeaux” under French law. *See* 27 C.F.R. §§ 4.24(c), 4.39(i).

8. The AOC “Bordeaux” is, and has been for many years prior to the date of filing of the subject application, a valid certification mark within the meaning of Section 45 of the Lanham Act, 15 U.S.C. § 1127, and indicates, and throughout that time period has indicated, the regional origin as well as the quality and characteristics of the products entitled to bear that designation under French law, pursuant to the standards established and enforced by the INAO and CIVB.

9. The AOC “Bordeaux” is, and has been for many years prior to the date of filing of the subject application, a famous mark within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

10. Applicant seeks to register “OR’DEAUX” as a trademark in International Class 33 in connection with “Acanthopanax wine (Ogapiju); Aperitif wines; Aperitifs with a wine base; Black raspberry wine (Bokbunjaju); Cooking wine; Dessert wines; Fortified wines; Fruit wine; Grape wine; Honey wine; Kits for making wine; Korean traditional rice wine (makgeoli); Natural sparkling wines; Port wines; Prepared wine cocktails; Red wine; Red wines; Rose wine; Rose wines; Sparkling fruit wine; Sparkling grape wine; Sparkling wines; Still wines; Strawberry wine; Sweet wines; Table wines; Tonic sweet grape wine containing extracts from ginseng and conchona bark (ninjin-kinatetsu wine); White wine; White wines; Wine; Wine coolers; Wine punch; Wine punches; Wine-based beverage, namely, piquette; Wine-based drinks; Wines and fortified wines; Wines and liqueurs; Wines and sparkling wines.”

11. On information and belief, the goods in connection with which Applicant uses or seeks to use the subject mark do not consist of AOC “Bordeaux” wines, do not originate in the Bordeaux region of France, or anywhere in France, and are not entitled to bear the protected AOC “Bordeaux.”

12. The subject mark consists of or comprises a geographical indication which, when used on or in connection with wines, identifies a place other than the origin of the goods. Accordingly, registration of Applicant’s mark should be refused under Section 2(a) of the Trademark Act of 1946, 15 U.S.C. § 1052(a).

13. Alternatively, Applicant’s purported mark, when used on or in connection with the goods, is primarily geographically deceptively misdescriptive of them within the meaning of Section 2(e)(3) of the Trademark Act of 1946, 15 U.S.C. § 1052(e)(3).

14. In addition, Applicant’s mark so resembles the protected AOC “Bordeaux” as to be likely, when applied to the goods of the Applicant, to cause confusion, or to cause mistake, or to deceive as to the source, sponsorship, or affiliation of Applicant’s goods within the meaning of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d).

15. Finally, Applicant’s purported mark, when so used, also would cause dilution of the AOC “Bordeaux” by blurring and by tarnishment within the meaning of Sections 13(a) and 43(c) of the Trademark Act of 1946, 15 U.S.C. §§ 1063, 1125(c).

16. The forms of damage that Opposers believe they or persons they represent are likely to suffer as a result of the registration of the Applicant’s mark include, but are not limited to, the disparagement of Bordeaux products produced and denominated in compliance with international agreement and United States law; the impairment of the rights of the Opposers and

their members in the exclusive use of the AOC “Bordeaux” as part of the “appellation of origin” classification and grading system; and the dilution of the “Bordeaux” name and the “Bordeaux” AOC.

For all the foregoing reasons, Applicant's alleged mark is not entitled to registration on the Principal Register under Section 2 of the Lanham Act, 15 U.S.C. § 1052 and Section 2.69 of the Trademark Rules of Practice, 37 C.F.R. § 2.69.

WHEREFORE, Opposers pray that application Serial No. 86/610,511 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposers.

Opposers hereby appoint Ropes & Gray LLP to act as their attorneys with full power to prosecute this opposition, to transact all relevant business with the Patent and Trademark Office, and to receive all official communications with respect to this opposition.

Respectfully submitted,


/Peter M. Brody/
Peter M. Brody, Esq.
ROPES & GRAY
One Metro Center
700 12th Street, N.W., Suite 900 East
Washington, D.C. 20005-3948

Attorneys for the Institut National
de l'Origine et de la Qualité and the
Conseil Interprofessionnel du Vin de Bordeaux

Dated: June 22, 2016

INSTITUT NATIONAL DE L'ORIGINE ET DE LA QUALITÉ,)	
)	
and)	Opposition No. _____
)	
CONSEIL INTERPROFESSIONAL DU VIN DE BORDEAUX,)	Application Serial No. 86/610,511
)	
Opposers,)	Mark: OR'DEAUX
)	
v.)	Published in the Official Gazette of February 23, 2016
)	
SMALL WORLD WINE COMPANY,)	
)	
Applicant.)	
)	

I HEREBY CERTIFY that on this 22nd day of June, 2016, a true and correct copy of this Notice of Opposition was served upon Applicant by first class mail, postage prepaid to:


Ronald M. Duvernay
ROPES & GRAY LLP